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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,341	03/12/2004	Marc Husemann	tesa 1605-WCG	9929

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/800,341

Applicant(s)

HUSEMANN ET AL.

Examiner

William K. Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-29 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 and 18-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In view of priority document filed September 23, 2005, the rejection of Claims 1, 3, 5, 7-9, 16 and 17 under 35 U.S.C. 102(e) as being anticipated by Raether et al. (U.S. Pub. No. 2003/0170306) is withdrawn. Further, the rejection of Claim 2 under 35 U.S.C. 103(a) as being unpatentable over Raether et al. (U.S. Pub. No. 2003/0170306) as applied to claim 1 above, and further in view of Yamamoto et al. (U.S. Patent No. 6,432,475) is withdrawn. The rejection of Claim 4 under 35 U.S.C. 103(a) as being unpatentable over Raether et al. (U.S. Pub. No. 2003/0170306) in view of Petrie "*Handbook of Adhesives and Sealants*" and further in view of Massow et al. (U.S. Patent No. 5,194,455) is withdrawn.

2. However, after a careful re-consideration, the withdrawn rejections of the non-final office action of December 29, 2004 are re-instated in order to resolve some additional issues.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 3-9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025).

The prior art to Massow et al. provides an acrylate-based hotmelt pressure sensitive adhesive comprising 55 to 98% by weight of acrylic alkyl ester (column 3, line 42-46) wherein the general formula of alkyl esters of acrylic acid or methacrylic acid is identical to that indicated in Claim 1 (column 3, line 28-40, It is noted that the general formula in the prior art is wrong and it should be  $\text{CH}_2=\text{C}(\text{R})-\text{COOR}'$ ) and Massow et als' description for the acrylate alkyl ester appears to read on the polyacrlate component limitations in applicants claims 1 and 6-9. Massow et al. further disclose that the adhesive composition can contain additives and auxiliaries, such as antioxidants, sensitizers for UV corosslinking, fillers (for example 0.1 – 50%), resins or resin systems (column 4, line 36-41).

The difference between the prior art and the present invention is that even though Massow et al. disclose the amounts of the additives but do not specify the species for the additives used in their adhesive composition, for example, fillers.

The prior art to Guldbrandsen et al. disclose the additives that are used in a their invented hotmelt pressure sensitive adhesive formulation such as, aging inhibitors, crossinglinkers, plasticizers, accelerators (column 4, line 25-28) as required by claim 17. Guldbrandsen et al. also teach that their adhesive composition may have included fillers such as chalk (column 4, line 29-31), as required by claims 1, 3 and 4. Moreover, Guldbrandsen et al. disclose that their adhesive composition includes tackifier resins such as, the resins made of the rosins, aliphatic and aromatic hydrocarbon resins (column 4, line 56-64), as required by claim 16

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the species of the additives, as taught by Guldbrandsen et al., into Massow et als' adhesive composition in order to adjust and improve the properties of the resultant adhesive composition.

With regard to claim 5, as discussed above, the adhesive composition prepared by Massow et al. is substantially identical to the claimed composition. Therefore, It is the examiner's position to believe that the prior art composition must inherently possess the same shrinkback, as indicated in claim 5. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to the applicant to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

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5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (US Pub. 2003/0120101 A1).

The references to Massow et al and Guldbrandsen et al. are adequately presented in paragraph 16 above and is incorporated herein by reference.

The difference between the references and the present invention is that, even though Massow et al. include regulators during the polymerization (column 5, line 7-8), Massow et al. do not disclose the weight-average molecular weight of the polyacrylate product. However, the  $M_w$  of polyacrylate less than 500,000 is well known such as taught by Lai. The prior art to Lai discloses weight-average molecular weight of polyacrylate products less than 500,000 (Example 4-9, paragraph [0195-0214]) by using various chain transfer agents in the acrylate polymerization process. Therefore, it would be obvious for Massow et al. reference to obtain polyacrylate with a  $M_w$  less than 500,000 because similar chain transfer agent is used for both situations.

### ***Response to Arguments***

Applicant's arguments filed March 29, 2005 have been fully considered but they are not persuasive. Applicants argue that the specification contains "unexpected results" in shrinkback properties. However, because fillers do not shrink as much as compared to the matrix resin, the examiner has a reasonable basis to believe that the addition of fillers to a matrix resin would improve the shrinkback properties of the claimed adhesive.

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Therefore, the argued "unexpected results" are not sufficient for overcoming the rejection set forth because the argued "unexpected results" are "expected".

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung

Primary Examiner

October 8, 2005

**WILLIAM K. CHEUNG  
PRIMARY EXAMINER**